

REMARKS

Applicant has studied the Office Action of August 18, 2003 and offers the following remarks.

Claims 1-24 were rejected in view of Ramsey et al. (hereinafter "Ramsey") in view of Bohnert et al. (hereinafter "Bohnert") and Muehlberger et al. (hereinafter "Muehlberger"). Claims 3, 5, 7-10, and 18 were rejected over the base combination in view of additional references, but the base combination is common to the rejection of all the claims. Applicant respectfully traverses the rejections because this combination is improper.

When making a rejection, the Patent Office is obligated to consider references in their entireties. MPEP § 2141.02. Specifically, portions of a reference which teach away from a potential combination cannot be ignored. *Id.* In the present case, as will be explained below, Ramsey has portions therein which teach away from the combination advanced by the Patent Office. Furthermore, even if Ramsey does not teach away from the combination, the Patent Office must advance a reason to combine the references. This reason must come from the prior art and not from Applicant's disclosure. MPEP § 2143.01. In the present case, the motivation advanced by the Patent Office relies on impermissible hindsight. Still further, if a reference must be modified such that it is no longer suitable for its intended purpose, then it is improper to say that the modification is obvious. *Id.* In the present case, the Patent Office's proposed combination renders one of the references unsuitable for its intended purpose, and thus, the modification advanced by the Patent Office is not obvious.

Initially, Applicant refers the Patent Office to column 12, lines 14-35 of Ramsey which indicate that a credit purchase cannot be made simultaneously with a cash purchase and vice versa. At lines 29-33, it specifically says that the cash console is disabled in the event of a card transaction. To this extent, Ramsey specifically teaches away from using a card and receiving cash as change. If cash cannot be received as change in a card transaction because the cash side has been disabled, then the claimed cash back feature cannot be used in Ramsey's device. Since Ramsey teaches away from the modification required to arrive at the present invention, the combination advanced by the Patent Office is improper and the claims are allowable.

Even if Ramsey does not teach away from the combination (a point which Applicant does not concede), the Patent Office must still advance a motivation to combine the references that is not drawn from Applicant's disclosure. The Patent Office indicates at page 3, lines 3-7 that it

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would have been obvious "... to provide cash back due to user request in the combined system of Ramsey and Bohnert. This would add to the convenience of the self serve fuel pump as it would allow a person to withdraw from an account at time of fuel 'fill up.'" The Patent Office provides no analysis as to where in the references or the prior art this motivation can be found. Additionally, this is essentially the motivation described in Applicant's disclosure. Thus, the Patent Office, on face, is relying on impermissible hindsight to provide the motivation to combine the references.

Even if the Patent Office is not relying on impermissible hindsight (a point which Applicant does not concede), the Patent Office, in its combination, has modified Muehlberger to the point where it no longer serves its intended purpose. This is evidence of non-obviousness. Specifically, Muehlberger's intended purpose, as evidenced by the title, the first line of the abstract, and the first paragraph of the Summary (column 1, lines 54-60), is to provide a counter top card terminal. The counter top card terminal is designed so that it can be used in smaller specialty stores and avoid high credit card transaction fees. By modifying Muehlberger to work in a fuel dispenser, the device is no longer suitable for use as a counter top device. Thus, the Patent Office's modification renders Muehlberger unsuitable for its intended purpose. This is yet another reason why the combination advanced by the Patent Office is improper and the claims are allowable.

Applicant requests reconsideration of the rejection in light of the arguments presented herein and claim allowance at the Examiner's earliest convenience.

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Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

Taylor M. Davenport
Registration No. 42,466
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

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